



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/517,977	03/03/2000	Dean Boyd	20113.0001U2	5716

24633 7590 04/15/2004
HOGAN & HARTSON LLP
IP GROUP, COLUMBIA SQUARE
555 THIRTEENTH STREET, N.W.
WASHINGTON, DC 20004

EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/517,977

Applicant(s)

BOYD ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

UW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/03/00 & 01/23/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The oath or declaration filed on June 05, 2000 and January 23, 2004 are defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.
 - 2.1 The oath or declaration filed on June 05, 2000 is defective because:
 - A) it does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
 - 2.1 The oath or declaration filed on January 23, 2004 is defective because:
 - A) inventor's Boyd and Guardino have not executed the supplemental declaration.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Art Unit: 3629

4.1 It is noted that the amendment filed January 23, 2004 improperly renumbers claims 8-14 and 22-28.

5. Claims 24, 26 & 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In view of the proposed improper renumbering of claims 22-28, as amended both claims 24 & 26 depend from claim 24 & 26, respectively, hence the scope and meaning of these claims can not be determined.

5.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6.1 Claims 1-37 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.1.1 Although the instant claims recite:

1) a method, (claims 1-37), which has a disclosed practical application in the technological arts, and

2) which does not define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon,

the instant claims merely define a series of steps to be performed on a computer.

6.1.2 In regard to claims 1-37, the invention as set forth in these claims merely describes:

A) manipulating numbers with in a computer system.

However, as recited in the claims the mere manipulation of numbers with in a computer does not require either:

A) a pre-manipulation of the data by an external devices, or

B) that the result of the manipulation as claimed to have practical application by external devices;

in order for the result to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a tangible application with in the technological/useful arts.

6.1.3 It is further noted that applicant has not recited in the claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either altered or changed or modified by the invention recited in claims.

6.1.4 It is further noted that applicant has not claimed either:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or changed before it is processed, or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation is either manipulated or used or changed by any device after it has been processed.

6.1.5 In view of the above, the invention of claims 1-37 merely manipulates the abstract idea of manipulating numbers/data with in a computer with out any practical application of the result.

6.1.6 In view of the above, it is further noted that the invention of claims 1-37 lacks a claimed practical application since the claimed invention:

A) is not used by any system or device or method outside of the claimed invention,

in a concrete and tangible manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

6.1.7 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

6.1.8 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application.

6.1.9 Hence, claims 1-37 are directed to non-statutory subject matter.

7. The following is an Examiner's Statement of Reasons for Allowance:

A) the prior art, for example:

(1) Burns et al (5,189,606) discloses a bidding system in which historical data and models are used to:

(a) determine the costs associated with an item for which the bid is to be made;

(b) determine of a price of an item that includes an associated profit for the item for which the bid is to be made;

(c) consider the affects of the competitor's bids; and

(d) determine the actual bid or target price to be used; and

(2) Messmer et al (2001/0037278) discloses in the environment of determining the optimum bid in a competitive bidding environment by considering of the competition when determining a target price/bid and the use of statistical analysis to determine the probability of the bid being the winning bid.

B) in regard to claim 1, the prior art does not teach or suggest determining target price for a value from an optimal winning value obtained by processing:

(1) a price value obtained using a list price data and a product model;

(2) a costing value obtained using a cost data and a product model; and

(3) an equivalent competitor net price obtained using a previously stored competitor net price model;

with a market response model. Claims 2-6 & 35 are allowable for the same reason.

Art Unit: 3629

B) in regard to claims 1 & 21, the prior art does not teach or suggest determining target price for a value from the probability of a winning value obtained by processing:

- (1) a price value obtained using a list price data and a product model;
- (2) a costing value obtained using a cost data and a product model; and
- (3) an equivalent competitor net price obtained using a previously stored competitor net price model;

with a market response model. Claims 8-20, 22-34, 36 & 37 are allowable for the same reason.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.2 As per the objection to the declaration, it is noted that as contained in the records of the Patent Office the declaration filed June 05, 2000 does not designate a Post Office address any of the three inventors, hence applicant's arguments are non persuasive.

8.3 As per the 35 U.S.C. § 101 rejection, since:

A) operations that are performed solely with in a computer are an abstract exercise in data analysis/manipulation the mere claiming of a computer/system/apparatus to perform the analysis/manipulation with a claimed practical application dose not change the abstract nature of the analysis/manipulation, and hence applicant's arguments are non persuasive.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

Art Unit: 3629

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

04/12/04

A handwritten signature in cursive script that reads "Edward Cosimano".

Edward R. Cosimano
Primary Examiner A.U. 3629